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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,039	05/20/2004	James T. Dalton	P-5235-US14	7024

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EXAMINER

KUMAR, SHAILENDRA

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/849,039	Applicant(s) DALTON ET AL.	
	Examiner SHAILENDRA -. KUMAR	Art Unit 1621	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) 21-23, 32-34, 38-51, 65-67, 76-78 and 82-95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 24-31, 35-37, 52-64, 68-75 and 79-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicants' communication filed on 4/26/06.

Claims 1-95 are pending in this application.

At the out set, claims 21-23 and 32 should be withdrawn as containing O-glucoronide containing group. See, restriction requirement of 8/15/05. Inclusion of claims 21-23 and 32 in Group I was an inadvertent error and is regretted. Thus elected claims are 1-20, 24-31, 35-37, 52-64, 68-75 and 79-81. Claims 22-23, 32-34, 38-51, 65-67, 76-78 and 82-95 stand withdrawn as none elected invention.

Rejection of claims 63, 69-75 and 79-81 under 35 USC 112 2nd paragraph is hereby withdrawn, subsequent to applicants' arguments.

Rejection of various claims under 35 USC 103 over Miller et al is hereby withdrawn subsequent to applicants' submission of a statement claiming common ownership.

Claim Rejections - 35 USC § 103

1. Claims 1-20, 24-31, 35-37, 52-64, 68-75 and 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teachings of WO 98/55153 and Tucker et al.

Instant claims are directed to anilide derivatives as metabolites wherein, Q can be among others, F or acetamido.

WO'153 teach structurally similar compounds and composition which are radiolabeled. See pages 6-7, wherein, R7 can be phenyl substituted with amino, F or alkylamido. The difference between the reference and herein claimed compounds and

composition is that the reference compounds are radiolabeled as against non radiolabeled compounds claimed herein.

Tucker et al are teaching structurally similar compounds and composition which are non radiolabeled, see column 1 through column 3.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify WO'153 and obtain non radiolabeled compounds and composition, as taught by Tucker et al, because the latter reference is expressly teaching that structurally similar compounds and composition can be non radiolabeled.

Applicants' arguments that Tucker does not teach metabolites, is of little if any probative value inasmuch as the compounds are structurally similar and the property of these compounds to be metabolite is inherent, absent evidence to the contrary.

Double Patenting

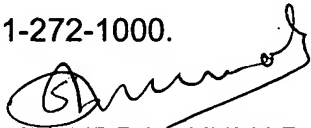
2. Claims 1-20, 24-31, 35-37, 52-64, 68-75 and 79-81 are again rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-85 of U.S. Patent No. 6,838,484, or over claims 1-10 of U.S. Patent No. 6,569,896, or over claims 1-5 of U. S. Patent No. 6,492,554, all for the reasons of record. Although the conflicting claims are not identical, they are not patentably distinct from each other because various substituents as claimed herein extensively overlap those in the above patents, and one of ordinary skill in the art would have obtained compounds within the generic disclosure of the above patents, because they are structurally so similar to those claimed herein, with the reasonable expectation of achieving a successful composition, absent evidence to the contrary.

Art Unit: 1621

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571)272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SHAILENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
6/30/06